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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,931	11/21/2000	Paul D. Arling	81230.578001	7074

34018 7590 06/20/2005

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CHICAGO, IL 60601-1732

EXAMINER
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YENKE, BRIAN P

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/718,931

Applicant(s)

ARLING ET AL.

Examiner

BRIAN P. YENKE

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Amendment (07 Feb 05).
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-9, 11 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-9, 11 and 15-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicant's arguments filed 07 Feb 05 have been fully considered but they are not persuasive.

#### ***Applicant's Arguments***

a) Applicant states that including the controller into the remote control would impermissibly remove the required step of comparing in the Lord system which would change the principle operation of the system.

#### ***Examiner's Response***

b) The examiner disagrees, if the controller was implemented into the remote control, the comparing step could still be performed. Thus the examiner requests the applicant to expound how this function could not be performed if it is included into the remote.

It is also noted that the independent claims have been amended to include "...without regard to a current state of media being played by the media device" is met by Lord since describes being able to change stations (channel surf) and then returning to the primary/remembered channel after a timed interval.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2a. Claims 6-9, 11,15, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lord, US 6,593,967.

In considering claim 6,

In considering claims 6, 15 and 21,

*a) the claimed a timer...* is met by fingerprint compare unit 42 which can adjust the confidence thresholds as a function of time (i.e. 30 second increments) (col 6, line 32-46).

*b) the claimed a memory* is met by fingerprint memory 41 (Fig 1).

*c) the claimed storing a primary channel...* is met by controller 20 which receives a user response, including the depression of remember key 26 or an alternative embodiment the controller 20 stores a primary channel when the user starts channel surfing.

*d) the claimed starting the timer...* is met by fingerprint compare unit 42 which can adjust the confidence thresholds as a function of time (i.e. 30 second increments) (col 6, line 32-46) when the user depresses remember key 26 or in the alternative embodiment when the user begins to channel surf.

*e) the claimed in response to expiration of the predetermined interval...* is met where once fingerprint compare 42 identifies a fingerprint match based upon the time increments (i.e. 30 seconds) of comparison, sends a signal to controller 20 which in turns selects the original program via main tuner 30 via main channel control 20a which is displayed for the user on monitor 31 (Fig 1).

As shown in Fig 1 the controller 20, fingerprint memory 41 and fingerprint compare 42 are shown outside of the remote control unit 25.

However, Lord does disclose that memory 41 and compare 42 may be implements in software and included in controller 20.

Thus the question is whether it would have been obvious to include controller 20 in the remote control unit 25.

The examiner relies on legal precedents that the mere integration of components (*In re Larson*, 340 F.2d 965,967,144 USPQ 347,349 (CCPA 1965); *In re Wolfe*, 251 F.2d 854, 855, 116 USPQ 443,444 (CCPA 1958) is considered to be an obvious modification to one of ordinary skill in the art.

Therefore, it would have been obvious to one of ordinary skill in the art to modify Lord which discloses a remote control unit 25 which sends commands to a controller 20 where the combination of both elements perform the necessary input/control functions of the system, by integrating the remote 25 and controller 20 which would reduce the number of separate elements in the system and increase the number of components/software in remote 25 but the integration would afford the user direct control of the system.

In considering claims 7 and 19,  
Is met by Lord where once the user starts channel surfing either after depressing the remember key or after watching a main program for a period of time and displays the main program when the main program is identified.

In considering claims 8, 9 and 11,

Lord discloses a system where the user either depresses a remember button 26 and starts channel surfing where the system will return the user to the program which

was airing when remember button 26 was depressed, or alternatively the user does not need to depress button 26, since the system tracks the amount of time a user has spent watching a program and if the time exceeds a predetermined threshold that is a tacit indication that the user wishes to remember the program after channel surfing (col 9, line 1-32). Also, a retroactive button may be placed where the user may use that button if the user forgot to press remember button 26 prior to channel surfing.

Thus the user may begin channel surfing either before/after depressing a retroactive or remember button respectively, or may channel surf without pressing any key before or after channel surfing which would also provide the user the original program prior to surfing.

2b. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lord, US 6,593,967 in view of Johnson, EP-0366001.

In considering claims 16, and 18,

Regarding the 3<sup>rd</sup> user input, Lord does not explicitly recite the user selecting a key for a duration greater than a duration required to effect the first or second input. However, the selection of a key for a duration being provided by/to the user is conventional in the art.

The examiner relies on Lord, which discloses in the background (EP-0366001) that conventionally users are able to operate a timer and select the time before returning to the main program (60 seconds, 90 seconds, etc) (col 1, line 52-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lord which discloses the automatic return to the main

program for the viewer while surfing by affording the viewer the ability to surf channels regardless if the main program has returned, where the viewer has the ability to customize how long he/she may surf channels without being redirected while surfing.

In considering claim 17,

Lord discloses a system where the user either depresses a remember button 26 and starts channel surfing where the system will return the user to the program which was airing when remember button 26 was depressed, or alternatively the user does not need to depress button 26, since the system tracks the amount of time a user has spent watching a program and if the time exceeds a predetermined threshold that is a tacit indication that the user wishes to remember the program after channel surfing (col 9, line 1-32). Also, a retroactive button may be placed where the user may use that button if the user forgot to press remember button 26 prior to channel surfing.

Thus the user may begin channel surfing either before/after depressing a retroactive or remember button respectively, or may channel surf without pressing any key before or after channel surfing which would also provide the user the original program prior to surfing.

### ***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Yenke whose telephone number is (571)272-7359. The examiner work schedule is Monday-Thursday, 0730-1830 hrs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John W. Miller, can be reached at (571)272-7352.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314**

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703)305-HELP.



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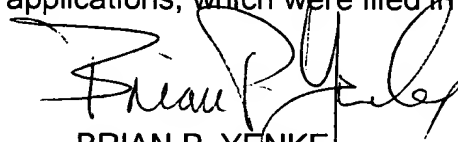
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BRIAN P. YENKE  
Primary Examiner  
Art Unit 2614



B.P.Y.

13 June 2005